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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,424	05/31/2001	Said Goueli	34506.105	9271

25005 7590 07/18/2003

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MADISON, WI 53717-1914

EXAMINER

WEBER, JON P

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 07/18/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,424

Applicant(s)

GOUELI ET AL.

Examiner

Jon P Weber, Ph.D.

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Status of the Claims

The response with amendments filed 06 May 2003 has been received and entered. Claims 31-46 have been presented for examination.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

Claims 31-46 are now rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

608.01(o) Basis for Claim Terminology in Description [R-14]

The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import, and in mechanical cases it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. A term used in the claims may be given a special meaning in the description. No term may be given a meaning repugnant to the usual meaning of the term.

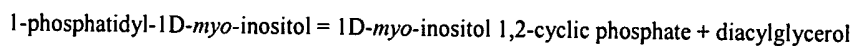
Usually the terminology of the original claims follows the nomenclature of the specification, but sometimes in amending the claims or in adding new claims, new terms are introduced that do not appear in the specification. The use of a confusing variety of terms for the same thing should not be permitted.

Claim 31 now recites "lipid phosphatase", "phospholipid phosphatase", "lipid kinase" and "phospholipid kinase" which do not appear to be art accepted names for enzymes, because no such enzyme names are listed by the International Union Of Biochemistry And Molecular Biology (IUBMB Enzyme Nomenclature - <http://www.chem.qmw.ac.uk/iubmb/>). While a person of ordinary skill in the art gets the general idea of the kinds of enzymes envisaged, enzymes

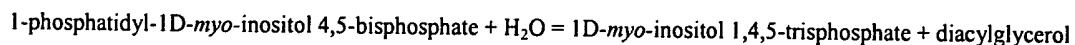
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adding or removing phosphate to lipids and phospholipids, the metes and bounds of the claims are not clear. For example, is "phospholipid phosphatase" supposed to be phospholipase C, phospholipase D, or some other enzyme? What about "phospholipid kinase"? Where is the additional phosphate being added? There are a large number of enzymes listed at pages 16-21 of the disclosure. However, many of the listed enzymes are not encompassed by the instant claims. Further the question remains of whether it is the intention to limit the scope of the claims to those enzymes specifically set forth at these pages. If so, it must be remembered that while claims must be "given the broadest reasonable interpretation consistent with the specification", "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." *In re Prater*, 162 USPQ 541, 550 -51 (CCPA 1969). This is impermissible importation of subject matter from the specification into the claim.

Claim 38 recites "EC 3.1.4.10" which lacks antecedent basis. This is a transferred entry: now EC 4.6.1.13, phosphatidylinositol diacylglycerol-lyase. As there is no hydrolysis of the inositol 1,2-cyclic phosphate formed, previous classification of the enzyme as a hydrolase was incorrect. (according to IUBMB Enzyme Nomenclature *vide supra*). Reaction is:



Claim 38 recites "EC 3.1.4.11" which lacks antecedent basis. No phosphate is released in this reaction as required by claim 31:



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All other claims depend directly or indirectly from rejected claims and are, therefore, also rejected for the reasons set forth above.

Withdrawal of Pending Rejections under 102/103

Applicant's arguments, see Paper #13, filed 06 May 2003, with respect to the Office action of 03 February 2003 have been fully considered and are persuasive. The rejections under 102 and 103 over Toomik et al. have been withdrawn despite factual errors in the response. In particular issue is taken with respect to the mechanism of kinases/phosphatases. For the instant purposes, all these enzymes involve **phosphoryl transfer** either via SN2 pentacovalent intermediate or SN1 trigonal planar intermediate. Reaction mechanism and regulatory control mechanism are entirely different phenomena. The relevant element is the common phosphoryl transfer to or from the substrate. Nevertheless, because Toomik et al. only disclose phosphoryl transfer to or from **peptidyl** substrates and do not reasonably suggest the now claimed **lipid-based** substrates, the rejections cannot be sustained. The secondary references do not remedy this deficiency of Toomik et al.

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

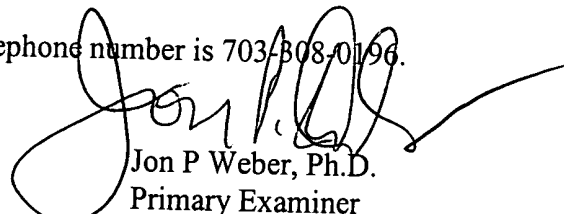
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon P Weber, Ph.D. whose telephone number is 703-308-4015. The examiner can normally be reached on daily, off 1st Fri, 9/5/4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 703-308-4743. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Jon P Weber, Ph.D.
Primary Examiner
Art Unit 1651

JPW
July 17, 2003